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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,976	12/13/2001	Michael Salvatore Ferritto	DC4979	8374

7590 12/24/2003

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EXAMINER

ROBERTSON, JEFFREY

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/017,976	Applicant(s) FERRITTO ET AL.	
	Examiner Jeffrey B. Robertson	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 8-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 and 8-22 is/are allowed.
- 6) ☒ Claim(s) 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: in paragraph [0014], what is the definition of oxygen radicals (O)? Does this fall within the definition of F or are oxygen radicals meant to be a separate definition of Y? Applicant provides no further definition in the specification. In the amendments to paragraphs [0020] and [0040], the replacement paragraphs contain paragraph numbers [0001] and [0002], which do not correspond to the numbers of the paragraphs replaced.

Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 23 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 6,653,378 in view of Hill et al. (U.S. Patent No. 5,665,804, cited in the previous office action).

For claim 23, in claim 19 of the '378 patent, Ferritto sets forth a silicone elastomer in the form of a gel and or an organized structure. Using the specification as a dictionary, Ferritto teaches that organized structure means microemulsions. Applicant is claiming an emulsified mixture in claim 23 of the instant application. For component (I), applicant claims a siloxane oligomer with a Y_3Si-O- unit, where the unit and definitions of the variable Y are the same as set forth in claim 19 of the '378 patent. Both claim 23 and 19 require the presence of 50 mol% R' groups and at least two Z and/or Z' groups in the siloxane.

Both claims 19 and 23 claim a crosslinker as component (II) that has the same requirements for the Z and Z' groups.

Claim 23 also contains (III) and emulsion liquid. This corresponds to component (IV) set forth in claim 19 of the '378 patent.

Claim 23 sets forth component (IV), a surfactant. This corresponds to component (III) of the '378 patent, where the compound with functional group F is a surfactant. Note that F contains groups such as polyether and quarternary ammonium salt groups.

Claim 19 of the '378 patent fails to teach the presence of an active ingredient selected from the group consisting of sunscreens, fragrances vitamins, drugs, antiperspirant salts and alpha-hydroxy acids.

Hill teaches siloxane-containing solvent compositions, where the siloxane may contain epoxy groups. Hill teaches that the compositions are used in applications such

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as personal care compositions in column 11, lines 1-32. Here, Hill teaches that these compositions are carriers for perfumes, sunscreens, pigments, and vitamins.

Hill and Ferritto are analogous art in that they both teach polysiloxane compositions in the form of organized structures (emulsion compositions). It would have been obvious to one of ordinary skill in the art at the time of the invention to add an active ingredient such as perfumes, sunscreens, pigments, and vitamins to the compositions of Ferritto. The motivation would have been that Hill teaches that these type of compositions are used as personal care compositions. Depending on the end use desired, one of ordinary skill in the art would have added active ingredients targeted for the particular use desired.

Allowable Subject Matter

4. Claims 1-4 and 8-22 are allowed.

Conclusion

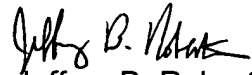
5. The examiner has included PTO-1449, previously signed by the examiner. In reviewing the file the examiner noticed that he had failed to initial the two PCT documents even though the bottom of the form was signed. The examiner has corrected this deficiency and has included a copy in order to complete the file.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Jeffrey B. Robertson
Examiner
Art Unit 1712

JBR
December 12, 2003